

Attorney Docket # 5255-32PRCE

MS-AF
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Hubert ELMER et al.

Serial No.: 10/509,822

Filed: September 30, 2004

For: Separating Wall

Examiner: CHAPMAN, J. E.
Group Art: 3635

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August 18, 2008

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

This is a Request for a Panel Review of Issues on Appeal. A Notice of Appeal is filed concurrently herewith in response to the final Office Action dated April 18, 2008. No amendments are being filed with this Request.

Arguments supporting the Request for Review begin on page 2 of the present communication.

ARGUMENTS

The matter to be reviewed in this Request is whether the Examiner has established a *prima facie* obviousness case against claims 10-14 and 17-20 based on *WO 94/27019 (WO '019)* in view of *DE 34 25 765 (DE '765)* and U.S. Patent 4,912,898 (*Holmes*).

Independent claim 10 recites, at least, “a permanently elastic mass arranged between the transom panel and the side panels and in the channels” and “the transom panel being connected in frictional engagement with the side panels and with the top structure by the permanently elastic mass.”

Applicants submit that the Examiner failed to establish a *prima facie* obviousness case against independent claim 10 for at least the following reasons: (A) the combined art does not disclose the above features recited in independent claim 10 because the glass panel assemblies in *Holmes* are not connected by the exterior sealant 58 but rather by an interior frame work member such as a mullion 45; and (B) one skilled in the art will not be motivated to replace the connectors of *WO '019* with *Holmes's* teachings of butt joints, as is proposed in the Office Action, because such proposed modification of *WO '019* would change its principle of operation and hence is impermissible (*see*, MPEP § 2143.01VI).

(A)

Neither *WO '019* nor *Holmes* teaches the above recited claim features.

The Examiner acknowledges that *WO '019* “lacks the permanently elastic mass between the transom panel and the side panels and the transom panel being connected in frictional engagement with the side panels by the permanently elastic mass” (*see*, page 4 of the Office Action). The Examiner then cites *Holmes* for its alleged teachings of a permanently elastic mass 53/58 and takes the position that it would have been obvious to one skilled in the art to apply such alleged teachings in *Holmes* to *WO '019* to arrive at the claimed invention.

Applicants respectfully disagree with the Examiner's position.

Holmes teaches forming glass panel assemblies 10a, 10b and securing the same to mullions 45 by sealant. For example, *Holmes* teaches that assembly 10a is glazed to the mullion 45 by glazing compounds or sealant 55 (see, col. 8, ll. 24-27). A second assembly 10b can be similarly glazed to the mullion 45 and adjacent to the first assembly 10b. An exterior sealant 58 is used to produce a glazed exterior butt joint of superior appearance and strength (see, col. 9, ll. 7-15 of *Holmes*).

The Office Action states that the exterior sealant 58 discloses the claimed permanently elastic mass. However the exterior sealant 58 of *Holmes* fails to connect any parts by frictional engagement. In contrast the above teachings of *Holmes* disclose that adjacent glass panel assemblies 10a, 10b in *Holmes* are connected next to each other by an interior frame work member, or the mullion 45. There is no teaching in *Holmes* that the glass panel assemblies 10a, 10b are connected by the exterior sealant 58 (which is interpreted as "the permanently elastic mass" by the Office Action) in frictional engagement, as is recited in independent claim 10. Therefore, *Holmes* does not remedy the above stated deficiencies of *WO '019*.

DE '765 and *Oscari* are cited in the Office Action concerning other features recited in independent claim 10 and thus do not remedy the above deficiencies of *WO '019*.

In view of the above, the above recited claim features of independent claim 10 are not taught by the cited art, either taken individually or combined as a whole. Therefore, independent claim 10 is not obvious over the cited art.

(B)

Moreover one skilled in the art will not be motivated to substitute the connectors in *WO '019* with the alleged permanently elastic mass 53/58 in *Holmes* to arrive at the claimed invention.

WO '019 concerns a connector for securing plate-like wall components. In *WO '019*, the connector is formed so that it requires only a centering and/or semicircular hole, instead of complex cutouts, in the glass plates. More specifically, the connectors of *WO '019* are designed as connector halves 10, 15, 22, which are adapted to be inserted into the hole in the glass plate from both sides and are then bolted together, *e.g.*, by means of a threaded fitting. See, page 3 of the English translation.

As one skilled in the art will appreciate, the respective connectors in *WO '019* and *Holmes* are of different types, which operate on different principles. If the connectors in *WO '019* are replaced by the permanently elastic mass 53/58 taught by *Holmes*, as is suggested in the Office Action, then the principle of operation of the connectors in *WO '019* will be altered. Such proposed modification of *WO '019* is thus impermissible under MPEP § 2143.01VI.

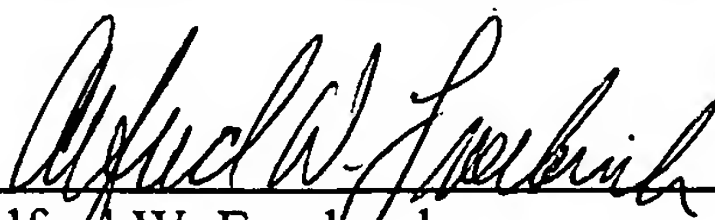
Accordingly, it is not obvious apply the teachings of permanently elastic mass 53/58 in *Holmes* to *WO '019* in order to arrive at the invention recited in independent claim 10.

In light of the foregoing, independent claim 10, as well as its dependent claims 11-14 and 17-21, patentably distinguishes over the cited art. The subject patent application is thus deemed to be in condition for allowance and notice to that effect is respectfully solicited.

Respectfully submitted,

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